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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,367	11/12/2003	Sumant Kamboj	004.0109C1	1170

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,367

Applicant(s)

KAMBOJ, SUMANT

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30,34-43 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30,34-43 and 47-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The disclosure is objected to because of the following informalities:

The continuing date needs to be updated **(i.e. the patent number of the application needs to be defined)**. Appropriate correction is required.

Since the limitations of previous claim 33 (previously rejected under 103(a)) have been defined in the independent claims, the 102 rejections have been withdrawn.

Claim 30, 34, 35, 38-43, 47, 48 and 51-53 are rejected under 35 U.S.C. 103(a) as obvious over James et al. in view of in view of Shamouillan et al. or Newell for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 36, 37, 49 and 50 are rejected under 35 U.S.C. 103(a) as obvious over James et al. in view of Bruxvoort et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 30, 34-43 and 47-53 are rejected under 35 U.S.C. 103(a) as obvious over Charvat (589) in view of James et al. and/or Bruxvoort et al. or Shamouillan et al. or Newell for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 30, 34-43 and 47-53 are rejected under 35 U.S.C. 103(a) as obvious over Charvat (420) in view of James et al. and/or Bruxvoort et al. or Shamouillan et al. or Newell for the same reasons set forth in the previous office action which are incorporated herein by reference

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Claims 30, 34-43 and 47-53 are rejected under 35 U.S.C. 103(a) as obvious over Bruxvoort et al. in view of James et al. or Shamouillan et al. or Newell for the same reasons set forth in the previous office action which are incorporated herein by reference

Claims 30, 34-43 and 47-53 are rejected under 35 U.S.C. 103(a) as obvious over Narayanan et al. in view of James et al. and/or Bruxvoort et al. or Shamouillan et al. or Newell.

Applicant's arguments filed 3/8/05 have been fully considered but they are not persuasive.

In applicants response, individual primary references were commented on alone and a broad argument was made to the combination rejections. The examiner will comment on applicants remarks of the reference in the same order as that are defined in the response.

(1) Applicant argues that James et al. does not teach the use of a friable fillers. The examiner acknowledges this but the reference defines that a filler, in general, can be added and the broad interpretation of "fillers" encompasses and makes obvious any filler because "a generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)". In addition, James et al. defines that a filler, in general, can be added and this makes obvious talc because talc (which is a friable filler) is known to be used and therefore obvious for the reasons defined in the previous office action (i.e. see rejection with Bruxvoort et al.). Applicant also argues that James et al. fails to teach or suggest the ratio between the filler and binder resin,

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however, this reference teaches amounts for the filler and binder and when these amounts are calculated in terms of a ratio, said ratio will encompass the claimed ranges.

(2) applicant argues that Charvat (589) does not teach an article that has a polishing surface for performing chemical mechanical polishing” however, this statement is the intended use of the article which provides no patentable weight. In addition, applicant argues that the reference does not teach that the surface is constructed “to continually wear during polishing and thereby facilitate continuous exposure of the abrasive”. Although this limitation is not literally defined, it is the examiners position that during the grinding (i.e. has a grinding surface) operation, the grinding surface will wear to an extent and therefore the abrasive, which is defined as being embedded in the matrix, will become exposed as the matrix is worn absent to applicants position and absence of any evidence showing the contrary. Applicant also argues that this reference does not teach or suggest a friable filler. This is not persuasive because the reference clearly teaches that filler can be added (mica) and mica can be considered to be a friable filler absent evidence to the contrary (see its hardness –2.8). Assuming any further arguendo about the filler (i.e. the filler is aluminum oxide which is an abrasive), the reference state that the abrasive can be talc which is the claimed friable filler and irrespective of what the component is called, it is known to be present in the composition. In addition, the reference implies that fillers, in general, can be added and makes obvious talc because talc (which is a friable filler) is known to be used and therefore obvious for the reasons defined in the previous office action (i.e. see rejection with Bruxvoort et al.). Applicant also argues that the reference fails to teach an epoxy resin used in the claimed amount. The reference clearly teaches in column 18, line 36 that an epoxy resin can be used and the examiner has made an obviousness determination for the

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amounts based on a combination of references and applicant has not clearly and persuasively argued this rejection (reference combined with James et al.)

(3) applicant argues that Charvat (420) does not teach an article that has a polishing surface for performing chemical mechanical polishing” however, this statement is the intended use of the article which provides no patentable weight. In addition, applicant argues that the reference does not teach that the surface is constructed “to continually wear during polishing and thereby facilitate continuous exposure of the abrasive”. Although this limitation is not literally defined, it is the examiners position that during the grinding (i.e. has a grinding surface) operation, the grinding surface will wear to an extent and therefore the abrasive, which is defined as being embedded in the matrix, will become exposed as the matrix is worn absent to applicants position and absence of any evidence showing the contrary. Applicant also argues that this reference does not teach or suggest a friable filler. This is not persuasive because the reference clearly teaches that filler can be added (mica or gypsum) and mica and gypsum can be considered to be a friable filler absent evidence to the contrary (hardness values less than 3). Assuming any further arguendo about the filler (i.e. the filler is quartz which is an abrasive), the reference state that the abrasive can be talc which is the claimed friable filler and irrespective of what the component is called, it is known to be present in the composition. In addition, the reference implies that fillers, in general, can be added and makes obvious talc because talc (which is a friable filler) is known to be used and therefore obvious for the reasons defined in the previous office action (i.e. see rejection with Bruxvoort et al.). Applicant also argues that the reference fails to teach an epoxy resin used in the claimed amount. The reference clearly teaches that an epoxy resin can be used and the examiner has made an obviousness determination for the

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amounts based on a combination of references and applicant has not clearly and persuasively argued this rejection (reference combined with James et al.) In addition, the reference defines in column 12, line 46 ratios for the particulate material/resin.

(4) applicant argues that Narayanan et al. does not teach an article that has a polishing surface for performing chemical mechanical polishing” however, this statement is the intended use of the article which provides no patentable weight. In addition, applicant argues that the reference does not teach that the surface is constructed “to continually wear during polishing and thereby facilitate continuous exposure of the abrasive”. Although this limitation is not literally defined, it is the examiners position that during the grinding (i.e. has a grinding surface) operation, the grinding surface will wear to an extent and therefore the abrasive, which is defined as being embedded in the matrix, will become exposed as the matrix is worn absent to applicants position and absence of any evidence showing the contrary. Applicant also argues that the reference fails to teach an epoxy resin used in the claimed amount. The reference clearly teaches that an epoxy resin can be used and the examiner has made an obviousness determination for the amounts based on a combination of references and applicant has not clearly and persuasively argued this rejection (reference combined with James et al.) .

(5) Applicant argues that Bruxvoort et al. does not teach the amount of resin. The examiner acknowledges this but has made an obviousness determination based on a combination of references and applicant has not clearly and persuasively argued this rejection (reference combined with James et al.).

(6) with respect to the combination rejections under 103(a), applicants argue that non of the references disclose the relationship between the amount of filler and amount of resin and that

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this relationship is important and therefore not obvious over the prior art.. Although the relationship might not be literally defined, as defined above and in the last office action, the amount of resin is obvious. Applicants have not shown any clear evidence to positively rebut the examiners basis for obviousness. A mere statement without and comparative evidence can not be used to overcome a combination when the specifics of the combination are not clearly argued. For example, James et al. teaches amounts for the filler and binder and when these amounts are calculated in terms of a ratio, said ratio will encompass the claimed ranges. Applicants have shown any evidence as to the criticality for the claimed amounts.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/05

MM


Michael A Marcheschi

Primary Examiner

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